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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/965,423

Applicant(s)

RIHAN ET AL.

Examiner

Tatyana Zalukaeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of claims 22-25 is persuasive and, therefore, the finality of that action is withdrawn.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited further comprises an (*sic*) hydroxyfunctional acrylic polymer having a number average molecular weight of less than about 5000 is indefinite because it is not clear if this is an additional polymer, or the same hydroxyfunctional polymer as in claims 16 and 24, but with different limit for molecular weight.

5. Claims 1-22 and 25 stand rejected under 35 U.S.C. 102(b) as being anticipated by Rink et al (U.S. 5,759,631).

Rink discloses **a refinish clear coating composition** comprising

(A) **at least one** hydroxyl group-containing polyacrylate resin obtained by polymerizing

(a) from **5 to 80% by weight of a cycloaliphatic ester** of methacrylic acid and/or acrylic acid, or a mixture of such monomers,

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(b) from 10 to 50% by weight of a hydroxyl group-containing alkyl ester of methacrylic acid and/or acrylic acid, or mixtures of such monomers,

(c) from 0 to 25% by weight of a hydroxyl group-containing, ethylenically unsaturated monomer, different from (a) and (b), or a mixture of such monomers, (reads on second hydroxy functional monomer)

(d) from 5 to 80% by weight of an aliphatic ester of methacrylic and/or acrylic acid, different from (a)-(c), or a mixture of such monomers,

(e) from 0 to 40% by weight of an aromatic vinyl hydrocarbon, different from (a)-(d), or a mixture of such monomers, and

(f) from 0 to 40% by weight of an additional ethylenically unsaturated monomer, different from (a)-(e), or a mixture of such monomers, and

(B) at least one crosslinking agent. (see abstract).

The number average molecular weight is 1000 –5000 (column 2, lines 20-25).

This meets the limitations of the instant claims 1 and 16 . With specific regard to claims 5, 9, 13, the weight average $M_w = M_n \times \text{polydispersity}$, which is said to be lower than 5 (column 2, line 23) , preferably from 1.8 to 4 (column 3, lines 16-20). Thus inherently $M_w = 5,000 \times 4 = 20,000$, which satisfies the limitations of claims 1 and 5. The hydroxyl number of a polymer is 60-180 mg of KOH/g, which meets the limitation of the instant claim 9.

Monomers (d) and (e) described in column 5, lines 25-43 meet the requirements of claim 10.

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With specific regard to claims 18 and 19 Rink discloses that a coating composition employs crosslinking agent (B), which is selected from the group consisting of at least one **diisocyanate, polyisocyanate which contains isocyanurate** groups, and mixtures thereof. (see claim 11).

With regard to the process of coating, as per instant claim 16 Rink discloses the process summarized in claim 12, which is the process of the instant claim. The clear coating composition of Rink is designed for VOLVO.

With regard to the limitation of the instant claims 11 and 12 on a viscosity expressed in Stokes it is a base presumption, that since the compositions of the instant claims and Rink are identical and are made by essentially the same method, the properties even if not taught will be inherently the same. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore if the prior art teaches the identical chemical structure, the properties and characteristics applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705,709,15 USPQ2d 1655,1658 (Fed. Cir. 1990). Consult also *In re Fitzgerald*. In other words when the claimed compositions **are not novel**, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art.

Therefore all the limitations of the instant claims are either explicitly or inherently met by the disclosure of Rink.

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6. Claims 1-15, 22, and 23 stand rejected under 35 U.S.C. 102(b) as being anticipated by Rockrath et al (U.S. 5,716,678).

Rockrath discloses a clear coating composition and method of a production of two-coat finish on a substrate, a transparent lacquer composition containing a hydroxyl group-containing polyacrylate resin produced by polymerizing

(a) 10 to 51% by weight 4-hydroxy-n-butylacrylate or

4-hydroxy-n-butylmethacrylate or a mixture of 4-hydroxy-n-butylacrylate and 4-hydroxy-n-butylmethacrylate;

(b) 0 to 36% by weight of a hydroxyl group-containing ester of acrylic acid different from (a) or a hydroxyl group-containing ester of methacrylic acid or a mixture of such monomers;

(c) 28 to 85% by weight of an aliphatic or cycloaliphatic ester of methacrylic acid different from (a) and (b) with at least 4 C atoms in the alcohol residue or a mixture of such monomers;

(d) 0 to 3% by weight of an ethylenically unsaturated carboxylic acid or a mixture of ethylenically unsaturated carboxylic acids and

(e) 0 to 20% by weight of an ethylenically unsaturated monomer different from (a), (b), (c) and (d) or a mixture

of such monomers, into a polyacrylate resin with a **hydroxyl number from 60 to 200** number average molecular weight from **1,500 to 10,000**.(abstract). Component (b) is described in column 4, lines 28-40. With regard to specific limitations of claim 5 that

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recites the weight average molecular weight, $M_w = M_n \times \text{polydispersity}$, it is a base presumption that the weight average molecular weight is within the claimed range, since the polymers of Rockrath are essentially the same as instantly claimed and are made by essentially the same methods as those of the instant claims. It is also noted that the polydispersity of such polymers is usually larger than 2, which is evidenced above by Rink.

It is possible to employ a crosslinking compound (B), which are preferably derived from diisocyanates and contain isocyanurate groups (column 5, lines 49-56).

With regard to the properties that are not taught by Rockrath, the same rationale as applied for the Rink reference I incorporated herein in its entirety.

7. Claims 1-3, 5-21, 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/22646.

WO'646 discloses clearcoat refinish composition comprising a hydroxylcontaining acrylic polymer present in the amount between 60-90% in a composition and a polyisocyanate crosslinking agent (abstract). The hydroxyfunctional polymer is described on page 5, lines 15-30, wherein the hydroxyfunctional monomer is preferably 4-hydroxy-n-butyl(meth)acrylate, and the cycloaliphatic acrylate comonomer is within the range of 45-95% by weight and is preferably cyclohexyl methacrylate. The acrylic solution polymer typically has a number average molecular weight of 1,000-30,000 (page 6, lines 23-26). Crosslinking agents are disclosed on page 6, lines 27-31). The process of refinishing substrate, which is preferably an automotive part is described in

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details on page 10, lines 6-30. Table 6 on page 19 presents the values of hydroxyl numbers that are within the claimed range for the majority of working examples.

With regard to the properties that are not taught by WO'646, the same rationale as applied for the Rink reference I incorporated herein in its entirety.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 stand and claims 22-25 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application 09/886,742. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim clear coating composition comprising identical ingredients wherein the ranges of those components overlap with the ranges as instantly claimed. The difference between the two compositions is in preamble of claims in Application No. 09/886,742, which recites a refinish basecoat composition, while the instant Application calls for refinish

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clear coat composition. However, it is noted here that the preamble in composition claims recites a statement of intended use or purpose, and as a rule does not limit the scope of the claim, since the statements in preamble merely define the context in which the invention operates, *DeGeorge v. Bernier*, 226 USPQ 758,761, n.3 (Fed.Cir. 1985).

- It is the Examiner's opinion that the preamble language of No. '742 **does not provide the antecedent basis for terms in the body of the claim.**
- It is the Examiner's opinion that the language of the body of the claim set out the complete invention.
- It is the Examiner's opinion that the preamble language merely provides a statement of purpose or intended use.
- It is the Examiner's opinion that the preamble language is not essential to understand **limitations and/or terms in the claim body.**

Therefore, the claims of Application No. 09/886,742 are obvious variants of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

9. Since claims 22-25 are not rejected over Rink any more, and claims 16-20, 24, 25 are not rejected over Rockrath, the arguments to these claims will not be addressed.

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Appellants' arguments in Brief filed September 02, 2003 with regard to Rink reference and rejection of claims 1-22 and 25 have been considered but they are not persuasive.

The crux of Appellants' arguments appears to hinge on the statement that Rink's reference "does not sufficiently describe the present invention to place the public in possession of it". Applicants further elaborate that the reference "... uses very broad ranges of its parameters that include ranges unsuitable for achieving the benefit of the present invention.... and does not disclose that certain parts of certain parts of its ranges of certain specific parameters must be combined...". This is not persuasive because Rink expressly discloses each and every limitation of the extremely broad instant claims 1-4, 6-25. The range claimed by Rink 5-80%, incorporates a very broadly claimed range at least 45%. As stated in MPEP 2131.03 a specific data point is defined as either end point of the range or a disclosed data point of the reference. It has long been held that the disclosure in the prior art of any range within, overlapping or touching the claimed range, anticipates when the prior art range discloses the claimed range with sufficient specificity. In the instant case a person skilled in the art would have clearly envisaged the claimed "at least 45%" from the disclosed 10-80% range as per Rink.

The Declaration under 37 CFR 1.132 filed December 17, 2002 is insufficient to overcome the rejection of claims 1-21 based upon Rink as set forth in the last Office action because:

a) the evidence of the secondary considerations, such as unexpected or superior results, as Applicants try to show in is irrelevant to 35 USC 102 rejections and cannot

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overcome a rejection so based, In re Wiggins, 488 F. 2d 538,543, 179 USPQ 421, 425 (CCPA 1973), consult MPEP 2131.04.

b) the example in the Declaration utilizes a **single data point** within very broadly claimed range.

Next Applicants' argument resides in contention that Rink's examples disclose 14-23% of t-butylcyclohexyl acrylate content and the polymers containing this amount of t-butylcyclohexyl acrylate show molecular weight from 2400 to 2700. In response to this, Applicants are advised that disclosed examples and preferred embodiments do not constitute a teaching away from a **broader disclosure or nonpreferred embodiments**. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, **including nonpreferred embodiments**. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998).

With regard to Rockhart reference, Applicants arguments reside in contention that Rockhart does not disclose a clearcoat composition containing an acrylic polymer. This is not found persuasive, because the passage in lines 11-15 of col. 2 states ".... Two coat finish, in which in step 3 a nonaqueous **transparent** topcoat is applied. This coat is in details described in col.2, lines 15-35, discussed in the previous and present

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office actions, and does contain all acrylic comonomers in the ranges as instantly claimed.

With regard to the curing temperature, which Applicants allege to be in Rockhart 130-140°C, it is the Examiner's position that Rockhart discusses the temperature at which the top coat and the basecoat are baked together, not necessarily the curing temperature of acrylic resin. Furthermore, Applicants' arguments are more specific than the claims, because the curing temperature is not recited in the instant claims.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Resuming the above, Applicants are reminded that reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take this teaching in combination with his own knowledge of the particular art and be in possession of the invention, as per *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995), or *In re Sasse*, 207 USPQ 107 (CCPA 1980).

And furthermore, the disclosure in a reference must show the claimed elements arranged as in the claim, but need not be in identical words as used in the claim to be anticipatory. *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (703) 308-8819. The examiner can normally be reached on 9:00 - 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Tatyana Zalukaeva, Ph.D.
Primary Examiner
Art Unit 1713



November 14, 2003